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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,613	03/20/2001	Heinz Isak	49458	4678

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1350 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

EXAMINER

TUCKER, ZACHARY C

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 06/13/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,613

Applicant(s)

ISAK ET AL.

Examiner

Zachary C. Tucker

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by US 3,420,851 (Bloom et al).

The rejection of claims 1-4, as set forth in the previous Office action, dated 14 February 2003 (paper 10) is maintained.

Applicant has rebutted the rejection under 35 U.S.C. 102(b) based on the disclosure of US 3,420,851 (Bloom et al) by asserting that the reference neither expressly nor inherently describes each and every element of the claimed method, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987), and pointing out that claim 1 requires the "...water- and/or solvent-wet phenoxymethylbenzoic acids be dried at a temperature from 1° to 25°C above the melting point of the phenoxymethylbenzoic acid under the utilized reaction conditions..." which is not what the claim requires.

Claim 1 requires that the water- and/or solvent-wet phenoxymethylbenzoic acids be dried at a temperature from 1° to 25°C above their melting point. Therefore, if the water- and/or solvent-wet phenoxymethylbenzoic acid(s) are heated from 1° to 25°C above the melting point of said water- and/or solvent-wet phenoxymethylbenzoic acids, then they undergo drying, and the claim limitations are met. The citation from *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) does not state that each and every element of the claim must be expressly described in order for said claim to have been anticipated. Bloom et al discloses the process step applicant has set forth as the element of the claim that causes drying to

occur, hence Bloom et al describes the claimed method for drying inherently, even though the phrase "a method for drying" does not appear in the Bloom et al patent, which is consistent with the reasoning in the decision cited by applicant.

As stated in the previous Office action, dated 14 February 2003 (paper 10), Example I of Bloom et al discloses a synthesis of 2-phenoxyethylbenzoic acid, followed by extraction with benzene, washing with water, and a melting point determination. This first melting point determination produces a melting point range of from 118-122°C. The 2-phenoxyethylbenzoic acid is recrystallized from ethanol, and then another melting point determination is made, the second time giving a result of 125.5-126.5°C.

The first melting point determination alone, because the melting point is actually a 4-degree range, anticipates claims 1-4 because the sample of solvent-wet 2-phenoxyethylbenzoic acid began melting at 118°C, and then heating was continued until a temperature 4 degrees higher than the point of initial melting was reached. This sample, contained residual benzene, which was the solvent with which it was extracted.

The second melting point range is a one-degree range. This melting point determination anticipates claims 1-4 as well because the solvent-wet (ethanol-wet) 2-phenoxyethylbenzoic acid began melting at 125.5°C, then heating was continued until a temperature one degree higher than the point of initial melting was reached. This sample was crystallized from ethanol immediately before the second melting point was determined, therefore, it contains residue of that solvent.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Organic Chem Lab Survival Manual - A Student's Guide to Techniques 4th ed. James W. Zubrick "The Melting Point Experiment" pages 102-119, John Wiley & Sons (1997) teaches on page 102 that a melting point is not actually a point, but a range. The excerpt from the Zubrick text was supplied with the previous Office action.

Claim 1 refers to the melting point of the water- and/or solvent-wet phenoxymethylbenzoic acid, specifying that the compound must be heating from 1° to 25°C above the melting point thereof.

It is unclear whether the method requires heating from 1° to 25°C above the lower part of the melting point range or heating from 1° to 25°C above the upper part of the melting point range.

Undoubtedly, some compounds within the scope of the compound of the general formula in claim 1 are unknown, or at best, extremely rare and seldom encountered. The melting points of such compounds are completely unknown or at best, practically unknown. Applicant's arguments imply that (though the claim does not require it) the claimed method should be interpreted as requiring the water- and/or solvent-wet

phenoxymethylbenzoic acid to be heated from 1° to 25°C above the melting point that the phenoxymethylbenzoic acid would have if it were in an absolutely 100% pure state, containing no trace of an adulterant such as water or solvent. If this is how the claim is to be interpreted, then one of ordinary skill in the art must be able to find out the melting point of the phenoxymethylbenzoic acid in its 100% pure state *in advance* so that the metes and bounds of protection provided by claim 1, should it be patented, can be known.

With melting points of a substantial number of compounds of the formula I in instant claim 1 unknown or practically unknown, (therefore unavailable to one of ordinary skill in the art) the metes and bounds of the protection afforded by instant claim 1, if patented, would be unknown to one of ordinary skill in the art.

Instant claim 1 does not preclude the method of drying recited therein, where a mixture of compounds of formula I are dried. When mixtures of compounds of formula I (the claim does refer to the phenoxymethylbenzoic acid in the plural form), the melting point of such a mixture cannot always be determined, and cannot at all be determined in the case where exact proportions of the compounds are unknown. Such would be the case in a combinatorial chemistry library wherein many 2-phenoxymethylbenzoic acid derivatives are present in varying amounts.

The method of claims 1-4 is indefinite for all of the above reasons.

This action is non-final due to the new claim rejections under 35 U.S.C. 112, second paragraph.

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Conclusion

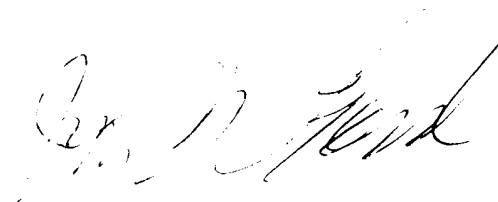
Any inquiry concerning this communication should be directed to Zachary Tucker whose telephone number is (703) 305-2050. The examiner can normally be reached Monday-Friday from 7:00am to 3:00pm. If Attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mukund Shah, can be reached at (703) 308-4716. The fax number for the organization where this application or proceeding is assigned is (703) 308-4556 for regular communications and (703) 308-4242 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

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JOHN M. FORD
PRIMARY EXAMINER
GROUP - ART UNIT 1624